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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/656,811	06/03/96	BARTSCH	D 50865/JPW/JM

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HM22/0619

EXAMINER

PAK, M

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/656,811

Applicant(s)

Bartsch et al.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 9, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 15, 16, and 18-22 is/are pending in the application.
- 4a) Of the above, claim(s) 1 and 3-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16, and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

DETAILED ACTION

*Continued Prosecution Application*

1. The request filed on 9 April 2001 (Paper No. 28) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/656,811 is acceptable and a CPA has been established. An action on the CPA follows.

*Response to Amendment*

2. The amendment filed on 9 February 2001 (Paper No. 25) has been entered.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Applicant's arguments filed 9 February 2001 (Paper No. 25) have been fully considered but they are not found persuasive.

5. Newly submitted claims 1 and 3-6 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 1 and 3-6 drawn to a method to de-repress cAMP responsive gene.

Since applicant has received an action on the merits for the

originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1 and 3-6 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MEP. § 821.03.

***Claim Rejections - 35 USC § 112***

6. Claims 15-16, and 18-22 remains rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for improving implicit long term memory in invertebrate animal subjects such as Aplysia and Drosophila using the methods as claimed, does not reasonably provide enablement for all subjects suffering from a memory defects nor provide enablement for treatment using a human homologue. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The reason for the rejection has been set forth previously.

Claims encompass a method of using a compound which inhibits the binding of a human homologue which encompasses a human protein with any structure with the functional property. However, the specification fails to teach how to use the human homologue treat memory defect. The specification in figure 1

discloses a specific species of human CREB-2 which is compared of structure of a specific Aplysia Creb2 of SEQ ID NO:1. The specification does not teach how to use the human homologue for treatment of memory defects in any animals. One skilled in the art would require undue experimentation to use any human homologue of SEQ ID NO:1 because it would require empirical experimentation to use human homologue in Aplysia or other animals to determine its effect on memory defect.

7. Claims 15-16, and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims encompass the term "human homologue" which is new matter because the specification does not disclose invention of the method of treating memory defect with a compound which inhibit binding of the generic "human homologue". The figure 1 discloses a specific species of human creb2 of disclosed sequence but does not teach the method of treating memory defect using compound which inhibit binding of the generic "human homologue".

8. Claims 15-16, and 18-22 are rejected under 35 U.S.C. 112,

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second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims encompass the term "human homologue" which is ambiguous and confusing because the metes and bounds of the term is not clear. The term is not limited by structure and the metes and bounds are not clear.

#### ***Claim Rejections - 35 USC § 102***

9. Claims 15-16 and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dash et al. (Nature, 1990).

Dash et al. teach the method of injecting CRE inhibit crebp in Aplysia and long term facilitation (figure 4).

The crebp and other creb proteins of Aplysia inherently has the claimed structure and function.

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this

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application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Michael D. Pak*

Michael Pak  
Primary Patent Examiner  
Art Unit 1646  
14 June 2001